



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,085	08/31/2000	Mikhail Lotvin		4318

7590 08/16/2004
Richard M Nemes
2231 56th Drive
Brooklyn, NY 11234-6840

EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/653,085	LOTVIN ET AL.	
	Examiner	Art Unit	
	Naeem Haq	3625	NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-12,23-25,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Appeal Brief

In view of the Appeal Brief filed on March 29, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

New corrected drawings are required in this application because the drawing(s) submitted are illegible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance. Also see PTO-948 for additional information.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim makes only nominal use of technology and is therefore not within the technological arts. *The claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d, 1665,1671 (Bd. Pat. App. & Inter. 2001))*. Although Bowman is not precedential, it has been cited for its analysis. The claims do recite technology in the preamble (i.e. "computer"). However, the preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the present case, the limitations within the body of claims 56 and 57 do not depend on the preamble for completeness. Finally, although claim 11 recites technology in the body of the claim (i.e. "electronically providing"), this recitation is deemed to be a trivial use of technology. The Examiner notes that the actual step of determining can be performed by hand and need not be performed on a computer or other electronic device. For these reasons, claim 11 is deemed to be non-statutory. To overcome this rejection, the Examiner recommends incorporating technological limitations into the body in a non-trivial manner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakasuji et al. (US 5,210,853).

Referring to claim 12, Nakasuji teaches electronically indexing using at least one index value into a compatibility dictionary (column 1, lines 6-13; column 3, lines 14-30; column 12, lines 9-58); and electronically extracting a compatibility designation based on the at least one index value (column 1, lines 6-13; column 3, lines 14-30; column 12, lines 9-58).

Referring to claim 32, the Examiner notes that this claim is parallel to claim 12, and a similar analysis applies to this claim. Furthermore, the structural elements disclosed by the Applicants and claimed in this claim using “means for...” limitations are also disclosed by Nakasuji.

Claims 11 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Rossides (US 5,749,785).

Referring to claim 11, Rossides teaches a computer-implemented method comprising: electronically providing to a first user to obtain a deal identifier, receiving from the first user a first electronic contract and the deal identifier, electronically providing a second user with the deal identifier, receiving from the second user a

Art Unit: 3625

second electronic contract and the deal identifier, and determining if the transmitted first and second contracts are compatible (Abstract; column 6, lines 30-62; column 8, lines 21-45; column 9, lines 51-67; column 33, lines 16-25; column 34, lines 30-38).

Referring to claim 31, the Examiner notes that this claim is parallel to claim 11, and a similar analysis applies to this claim. Furthermore, the structural elements disclosed by the Applicants and claimed in this claim using "means for..." limitations are also disclosed by Rossides.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 7, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Searcher et al. "Intelligent agents; a primer" hereinafter referred to as Searcher in view of Official Notice.

Referring to claims 1, and 3, Searcher teaches a computer-implemented method comprising: storing one acquisition specification of a first user represented in a scripting language that specifies acquisition requirements. Searcher teaches e-commerce agents compare and select prices based on a user's criteria (page 15, lines 19-22). The Applicants' specification teaches that an acquisition specification allows a user to specify, among other things, a price for a service (see specification page 2, lines 10-29).

Art Unit: 3625

Therefore the "criteria" described by Searcher in context of the e-commerce agent is an acquisition specification which specifies acquisition requirements. Searcher also teaches that rule-based reasoning (RBR) technologies are used to build intelligent agents (page 5, lines 22-42), and that these RBR techniques are of the form "IF...THEN" statements. The Applicants' specification teaches that a scripting language is specified and defined via an "IF-THEN-ELSE" control structure (see specification page 11, line 7 – page 12, line 17). Therefore, Searcher's RBR is a scripting language as defined by the Applicants. Searcher does not teach an "ELSE" clause in the "IF...THEN" statement. However, Official Notice is taken that the use of an "ELSE" clause in an "IF-THEN" statement is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate an "ELSE" clause in an "IF-THEN" statement. One of ordinary skill in the art would have been motivated to do so in order to avoid having to write a series of "IF-THEN" statements. Searcher also teaches parsing the acquisition specification into at least one purchase form comprising a plurality of attributes, at least one of which specifying a transactional action desired to be electronically completed by the first user (page 8, line 36 – page 9, line 9; page 15, lines 19-22). Searcher teaches agents handle sales transactions, and that they communicate with other agents via agent communication languages (ACL) such as KQML and FIPA. Therefore, the limitation of parsing the acquisition specification is inherent in the teachings of Searcher. To support this point of inherency, the Examiner cites the reference "Agent-Based Software Engineering" by Charles Petrie hereinafter referred to as ABSE. ABSE teaches that

Art Unit: 3625

parsing is inherent in ACL languages (page 9, paragraph 2; page 13, paragraphs 2 and 5). Furthermore, the Examiner notes that the Applicants' specification defines the term "purchase form" as a data structure (see specification page 6, lines 7-10). Therefore the use of a data structure to store data is inherent in Searcher because any information not stored in a data structure would be lost. Searcher also teaches receiving over the Internet and storing offering specification comprising at least one vendor form comprising a plurality of attributes, at least one of which specifying a transactional action desired to be electronically completed by a second user (page 8, line 36 – page 9, line 9; page 15, lines 19-22). Searcher teaches agents handle sales transactions, and that they communicate with other agents via agent communication languages (ACL) such as KQML and FIPA (page 4, lines 9-12). Furthermore, the Examiner notes that the Applicants' specification defines the term "vendor form" as a data structure (see specification page 6, lines 7-10). Therefore the use of a data structure to store data is inherent in Searcher because any information not stored in a data structure would be lost. Finally, Searcher does not explicitly teach the limitation "electronically determining if the attributes in the purchase form are compatible with associated attributes in the vendor form by testing attributes in the purchase form against attributes in the vendor form for satisfiability using a compatibility dictionary, comprising a storage of sets of compatible terms associated with an automated completion of a transaction, wherein the step of testing comprises accessing the storage of the dictionary and determining whether the transactional action in the purchase form is compatible with the transactional action in the vendor form." However, this limitation is rendered obvious.

Art Unit: 3625

Searcher teaches that agents handle sales transactions (page 15, lines 19-22).

Searcher also teaches that one of the key features of an agent is autonomy – the ability to act independently (page 2, line 35 – page 3, line 30). Searcher then goes on to teach that agents interact with other agents via an agent communication language (ACL) such as FIPA (page 4, lines 9-12; page 8, line 36 – page 9, line 9). Searcher teaches that FIPA is an ACL that standardizes, inter alia, an ontology for agent communication. The Examiner notes that an ontology is nothing more than a compatibility dictionary as defined by the Applicants (see specification page 8, lines 2-9; page 8, line 29 – page 9, line 31). To support this point, the Examiner cites the reference “My Agent Will Call Your Agent... But Will It Respond?” by Martin L. Griss hereinafter referred to as Griss. Griss teaches “...agents need to communicate using words that have agreed meanings, and which make sense in the given context” (page 9, section 5.1.1 “Ontology – What do words mean anyway). Griss goes on to teach that an ontology is a “...set of words, their relationships, and their meanings...” (page 9, section 5.1.1) and a domain specific vocabulary that defines meanings, key relationships between words such as synonyms and antonyms (page 10, lines 7-12). Finally, Griss teaches that E-commerce agents must use a common vocabulary or translate to a common vocabulary (page 11, lines 7-12). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the invention of Searcher using FIPA as the ACL. One of ordinary skill in the art would have been motivated to do so in order to obtain the benefit of a standardized ontology (i.e. compatibility dictionary) for agent communication, as taught by Searcher and Griss.

Art Unit: 3625

Referring to claims 7 and 10, Searcher does not teach that the acquisition specification comprises data related to at least one advertisement or using wireless communication. However, Official Notice is taken that an advertisement in an E-commerce transaction and using wireless communication are old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the invention of Searcher. One of ordinary skill in the art would have been motivated to do so in order to promote sale of a particular product and to use a commercially available and widely used medium as a method of communication.

Referring to claim 23-25, the Examiner notes that this claim is parallel to claim 1, and a similar analysis applies to this claim. Furthermore, the structural elements disclosed by the Applicants and claimed in this claim using "means for..." limitations are also disclosed by Searcher.

Claims 4, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Searcher et al. "Intelligent agents; a primer" hereinafter referred to as Searcher in view of Official Notice and further in view Gillman (US 2002/0147674 A1).

Referring to claim 4, Searcher does not teach storing the at least one acquisition specification on a personal page assigned to a user providing the acquisition specification. However, Gillman teaches that a buyer can store his acquisition specification on a personal page (page 4, paragraph [0036]; Figure 3). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was

Art Unit: 3625

made, to incorporate this feature into the method of Searcher. One of ordinary skill in the art would have been motivated to do so in order to allow a buyer to solicit business from a plurality of suppliers.

Referring to claim 5, Searcher teaches that agents need to know how to navigate an information space such as the World Wide Web (page 12, lines 33-39). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to receive an offering specification at the location where the personal page with the acquisition specification is stored. One of ordinary skill in the art would have been motivated to do so because the acquisition specification stored on the personal page is part of the World Wide Web and would be subject to the navigation of Searcher's agent.

Referring to claim 9, Searcher does not teach that voice recognition software is associated with the personal page and that the acquisition specification is provided using voice input. However, Official Notice is taken that voice input and voice recognition software it is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to alleviate the user from having to type in his or her specification.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Searcher et al. "Intelligent agents; a primer" hereinafter referred to as Searcher in view of Official Notice and further in view Gillman (US 2002/0147674 A1) and Dowling et al. (US 6,522,875 B1).

Art Unit: 3625

Referring to claim 8, Searcher and Gillman do not teach that the personal page communicates with Global Positioning System (GPS). However, Dowling teaches a geographical web browser that communicates with GPS (Abstract; column 2, line 63 – column 3, line 10; column 4, lines 47-62; column 11, lines 26-54; column 14, line 58 – column 16, line 25). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Dowling into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a mobile user to receive product and service information while on the road, as taught by Dowling (column 14, line 58 – column 15, line 11).

Conclusion

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a

Art Unit: 3625

copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

August 8, 2004

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER